

Application No.: 09/691,352

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**II. Remarks**

Favorable reconsideration of this application in the light of the following discussion is respectfully requested. Claims 20-25 and 32-34, previously withdrawn as subject to restriction and/or election requirement, have been canceled. Claim 36 has also been canceled and new claims 40-42 have been added. Support for these amendments can be found, for example, in original claims 1, 12, 26, and 28. No new matter had been added. Claims 1-19, 26-31, 35 and 37-42 remain pending for reconsideration.

**Withdrawn Rejections**

Applicants note with appreciation that the 35 U.S.C. 103 rejection of claims 1, 8, 26, 28, 29 and 36-38 over Miller et al. in view of George et al. have been withdrawn due to Applicant's arguments in Paper #12.

**Repeated Claim Rejections - 35 USC § 103**

Claims 1-19, 26, 27, 30, 31 and 35 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei (USPN 5,783,303).

The Office Action indicates as follows: Tsuei discloses an article with a plurality of ceramic granules (column 11, lines 47-51 and Figure 1, #16) bonded to a polymeric film (column 11, lines 28-30 and Figure 1, #11) by a radiation curable (column 4, lines 41-44) aliphatic urethane acrylic copolymer (column 4, lines 30-31). A variety of items may be added to the curable coating including pigments, dyes, ultraviolet absorbers, ultraviolet scavengers, fillers and adhesion promoters (column 7, lines 26-37). In order to improve adhesion to the coatings, the film may be primed (column 11, lines 43-45). The article may also be formed from a free-standing coating with a layer of adhesive to attach particles to the surface (column 12, lines 26-45). A size coating, sealant, of varying thickness is placed over the particles, completely covering some of the particles, and adhesive layer to help bond the particles to the film (column 10, lines 39-59). The article may be used as a floor covering (column 9, lines 59-64). The product has white ceramic granules (column 11, line 52) adhered to a film with transparent adhesive (column 10, lines 64-65 that was

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tested for flexibility, pliability (column 25, lines 14-24) and had a tensile elongation of 112% (column 25, lines 37-40).

It is further asserted that one of ordinary skill in the art would have recognized that the claimed integrated granule product would be pliable as determined by the flexibility test according to ASTM D-228-00 and ASTM D-882.97, and that the aesthetic color of granules are not affected by the cured adhesive since Tsuei teaches a composition made with ceramic granules adhered to a surface using an acrylated aliphatic urethane, which are the same parameters of the claimed invention. The Office Action concludes that one of ordinary skill in the art would readily determine the optimum flexibility and color affects depending on the end-desired results in the absence of unexpected results.

The Examiner acknowledges that Tsuei teaches solid ceramic granules instead of ceramic coated granules. However, the Examiner takes the position that the solid granules are performing an equivalent function to the Applicant's ceramic coated granules, unforeseen of any unexpected results from the coated ceramic granules. It is further indicated that if unexpected results are present from having the coated granules instead of solid particles, these results need to be presented to show that the granules are not equivalent functions.

#### **Response to Claim Rejections - 35 USC § 103 (Tsuei)**

Applicants respectfully traverse the rejection of claims 1-19, 26, 27, 30, 31 and 35 as being unpatentable over Tsuei. As acknowledged by the Examiner, Tsuei does not disclose "ceramic coated granules." Instead, the Examiner merely concludes that "the solid granules [of Tsuei] are performing an equivalent function to the Applicant's ceramic coated granules."

However, "in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents." MPEP 2144.06. The Examiner has offered no evidence that any such equivalency is recognized in the prior art. Applicants can find no such evidence in Tsuei. Thus, the Examiner has not met the required burden and the rejection should be withdrawn.

Further, it is noted that the mere fact that the prior art *may be* modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re*

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*Fritch*, 23 USPQ2d 1780, 83-84 (Fed. Cir. 1992). Should the Examiner be relying on information beyond the disclosure of Tsuei, applicants again respectfully request that the Examiner provide any such information that might support the Examiner's position in an affidavit, as required by 37 CFR §1.104(d)(2), since the mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability. See *In re Soli*, 137 USPQ 797 (CCPA 1963).

As Tsuei fails to teach or suggest "ceramic coated granules" as defined in the pending claims, a *prima facie* case of obviousness has not been established, and the rejection of claims 1-19, 26, 27, 30, 31 and 35 under 35 U.S.C. 103(a) should be withdrawn.

#### **New Claim Rejections - 35 USC § 103**

Claims 28, 29 and 37-38 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei.

In the Office Action, Tsuei is applied as noted in the repeated claim rejections. It is acknowledged that Tsuei fails to disclose the article being a roofing shingle or roll of roofing material, wherein the integrated granule product forms the exposed surface layer of a roofing material and wherein the integrated granule product is suitable as an exposed surface layer of a roofing material. In this regard, however, the Examiner indicates that it has been held that a recitation of the intended use of the claimed invention must result in structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

#### **Response to New Claim Rejections - 35 USC § 103**

Applicants respectfully traverse the rejection of claims 28, 29 and 37-38 as unpatentable over Tsuei. Claims 28, 29 and 37-38 all depend indirectly from patentable claim 1 and are therefore patentable over Tsuei at least on that basis.

Moreover, it is conceded that that Tsuei fails to disclose the article being a roofing shingle or roll of roofing material and wherein the integrated granule product forms the exposed surface layer of a roofing material (as defined by claim 37). This is not merely reciting an

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"intended use." Rather, claims 28 and 29 define a structured article that is a roofing shingle or roll of roofing material, and claim 37 defines an article wherein the integrated granule product structurally forms the exposed surface layer of a roofing material. These claims thus define articles that are structurally distinct from that disclosed in Tsuei.

For all of these reasons, a *prima facie* case of obviousness of the claims based upon Tsuei has not been established, and the rejection should be withdrawn.

#### Allowable Subject Matter

Claim 36 was objected to as being dependent upon a rejected base claim, but was indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 36 has been canceled and new independent claim 40 has been added. New claim 40 includes limitations previously found in claim 36. Claim 40, as well as new claims 41 and 42 that depend from claim 40, are in condition for allowance.

#### Conclusion

Favorable reconsideration of the present application and the passing of this case to issue with all claims allowed are courteously solicited. Should the Examiner wish to discuss any aspect of this application, Applicants' attorney suggests a telephone interview in order to expedite the prosecution of the application.

Respectfully submitted,

20 Jan 2004  
Date

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